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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/633,587 | 08/07/2000 | Geoffrey B. Rhoads | 60258 | 3357 |

23735 7590 10/21/2004

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

BURGESS, BARBARA N

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| ART UNIT | PAPER NUMBER |
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2157

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/633,587

Applicant(s)

RHOADS ET AL.

Examiner

Barbara N Burgess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to amendment filed July 19, 2004. Claims 1-25 are presented for further consideration.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-9, 11-12, 14-16, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al. (hereinafter "Schena", US 2001/0001854 A1) in view of Adams (US Patent No. 5,974,548).

As per claims 1, 12, Schena discloses a document management method, comprising:

- Presenting a paper sheet to an optical sensor, the sensor producing scan data comprising document image data, the paper sheet having an optically-detectable indicia thereon, the indicia being machine readable but not generally intelligible to a human viewer thereof (paragraphs [0006], [0008], [0013]);
- Wherein a single scan of said paper sheet permits acquisition of both an image of the sheet for archiving, and identification data by which stored image data can later be recalled (paragraphs [0006], [0008], [0033]).

Schena does not explicitly disclose:

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- Processing the document image data to decode binary identification data represented by said indicia;
- Storing said document image data in a data store, wherein the document image data can thereafter be accessed from the data store by use of said binary identification data.

However, in an analogous art Adams discloses scanning a document with a pattern that is unreadable by human vision into a bit map and storing the document in a memory device (column 2, lines 47-56, column 3, lines 6-11, 15-18, 21-23, 48-49, 61-67, column 4, lines 2-12, 33-36, column 6, lines 53-67, column 7, lines 53-67, column 8, lines 32-45).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate storing image data in a data store and wherein a single scan permits acquisition of both image and identification data in Schena's system in order to present a back-up copy of the document.

As per claims 4-8, Schena discloses the method of claim 1 comprising:

- Providing identification data ([0006], [0008], [0013], [0016]-[0018]);
- Using identification data to access the data store ([0030], [0032]-[0033]);
- Displaying data corresponding to said paper sheet on a computer screen ([0041]).

As per claims 9 and 20, Schena discloses the method of claim 1 wherein the indicia comprises a steganographic watermark (paragraph [0032], [0045]).

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As per claim 11, Schena discloses the method of claim 1 wherein the optical sensor comprises an array of plural photosensor elements (paragraphs [0006], [0008], [0013]).

As per claims 14-16, Schena discloses method of claim 12 in which said document data comprises a document image (paragraphs [0006], [0008], [0033]).

3. Claims 2-3, 18-19, 21-22, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al. (hereinafter "Schena", US 2001/0001854 A1) in view of Adams and further view of Hube.

As per claim 2, Schena discloses the method of claim 1.

Schena does not explicitly disclose wherein the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof. However, in an analogous art, Hube discloses documents marked with a small adhesive backed label with a machine-readable code (column 4, lines 14-16, 33-35, 57-65).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof in Schena's system in order for the scanner to know which documents to be skipped.

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As per claims 3 and 13, Hube further discloses the method of claims 2 and 12 wherein the adhesive note is a Post-It brand note (column 5, lines 1-5).

As per claim 18 Schena discloses a sheet of note paper having an optically-detectable indicia thereon, the indicia being machine readable but not generally intelligible to a human viewer thereof (paragraphs [0006], [0008], [0013]).

Schena does not explicitly discloses wherein the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof. However, in an analogous art, Hube discloses documents marked with a small adhesive backed label with a machine-readable code (column 4, lines 14-16, 33-35, 57-65).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof in Schena's system in order for the scanner to know which documents to be skipped.

As per claim 19, Hube further discloses the method of claim 18, wherein the adhesive note is a Post-It brand note (column 5, lines 1-5).

As per claim 22, Schena discloses the method according to claim 18.

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Schena does not explicitly disclose wherein the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof. However, in an analogous art, Hube discloses documents marked with a small adhesive backed label with a machine-readable code (column 4, lines 14-16, 33-35, 57-65).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof in Schena's system in order for the scanner to know which documents to be skipped.

As per claim 21, Schena discloses a sheet according to claim 18 wherein the indicia is a bar code (paragraph [0030]).

As per claim 25, Schena discloses a sheet according to claim 18 wherein the indicia is formed by texturing (paragraph [0032]).

4. Claims 10, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al. (hereinafter "Schena", US 2001/0001854 A1) in view of Adams and in further view of Reber et al. (hereinafter "Reber", 6,081,827).

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As per claims 10, 23-24, Schena discloses the method of claims 1 and 18.

Schena does not explicitly disclose the method of claim 1 wherein the indicia is formed on said sheet by ink jet printing. However, the use and advantages of using ink-jet printing is well known to one of ordinary skill in the art as evidenced by Reber (column 4, lines 61-67).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the use of ink-jet printing in Schena's system in order for data to be read by both optical readers and magnetic readers.

Response to Arguments

The Office notes the following arguments:

(a) Hube teaches any page bearing a sticker is not scanned or copied. This is contrary to applicant's claimed invention.

In response to:

(a) Applicant's argument has been considered but is moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (703) 305-3366. The examiner can normally be reached on M-F (8:00am-4:00pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Barbara N Burgess
Examiner
Art Unit 2157

October 15, 2004



SALEH NAJJAR
PRIMARY EXAMINER